

REMARKS

By the foregoing Amendment, Claims 1 and 25 are amended and Claim 11 is cancelled. Entry of the Amendment, and favorable consideration thereof, is earnestly requested. Claim 11 being cancelled herein, and Claims 10, 12 and 18-24 having been cancelled previously, Claims 1-9, 13-17 and 25 are currently pending.

Claims 1 and 25, the only independent claims, stand rejected under 35 U.S.C. 103(a) as being unpatentable over Fletcher et al. (U.S. Patent No. 6,022,353) in view of Miller et al. (U.S. Patent No. 5,306,285) and Fieni (U.S. Patent No. 5,280,676). Applicant respectfully asks the Examiner to reconsider this rejection in view of the above Amendments and the below Remarks.

An invention is not patentable "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103(a). For a claim to be rejected as obvious, the Office is required to determine the scope and content of the prior art, ascertain the differences between the claimed invention and the prior art, and resolve the level of ordinary skill in the art. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007); MPEP § 2141, citing *Graham v.*

John Deere Co., 383 U.S. 1 (1966). This analysis must be set forth explicitly. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007). When considering the prior art, the office is required to consider the prior art as a whole, and may not disregard portions of the art which show that an invention is not obvious. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983).

Additionally, it is important to guard against the use of hindsight when evaluating whether a claim is obvious. *E.g.*, *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning."). As a guard against hindsight, courts have identified certain scenarios in which it is improper to reject a claim as obvious. For example, a claim cannot properly be rejected as obvious when the principle of operation of the prior art would need to be modified to obtain the claimed invention. *In re Ratti*, 270 F.2d 810 (CCPA 1959) (cited in MPEP 2143.01 for the proposition that "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious."). Similarly, if a prior art reference teaches away from a claimed invention, then the claimed invention is not obvious over that prior art. See MPEP § 2145 citing *In re Grasselli*, 713 F.2d 731

(Fed. Cir. 1983). Given these standards, the Office's rejections under 35 U.S.C. § 103(a) cannot be sustained and must be reversed for the reasons set forth below.

It should be noted that Claims 1 and 25 have been amended to positively recite the fastener having a thickness, thereby giving more weight to the requirement that the step have a length at least equal to the thickness of the fastener. It should also be noted that Claims 1 and 25 have been amended to require, inter alia, that the plane defined by the second section is further from the manually driven apparatus than the plane defined by the first section, whereby the plane defined by the second section is closer to the workpiece during use than is the plane defined by the first section.

As has already been recognized by the Examiner, neither Fletcher et al. nor Miller et al. discloses, teaches or suggests a stepped configuration, which is why the Examiner has cited Fieni. Thus, clearly neither Fletcher et al. nor Miller et al. can disclose a stepped configuration having the precise configuration added by the above amendment. Applicant respectfully submits that Fieni also does not disclose, teach or suggest these features.

It is respectfully submitted that Fieni is not directed to a tool for making workpiece cuts in combination with an apparatus having a power driven output

shaft that oscillates about an axis. By contrast the tool according to Fieni is hand-driven only. In addition, the tool is driven in forward direction while the tool according to the invention is oscillated substantially in the direction of its straight cutting edge. As such, the "step" 136 of Fieni is completely different than the claimed step.

More specifically, as discussed above, Claims 1 and 25 have been amended to require, inter alia, that the step is configured so that the plane defined by the second section is further from the manually driven apparatus than the plane defined by the first section, whereby the plane defined by the second section is closer to the workpiece during use than is the plane defined by the first section. Fieni does not disclose, teach or suggest or suggest a step that is configured in this way, and indeed teaches away therefrom.

It should be noted that Fieni is directed to a totally different purpose than is the present invention, namely to facilitate removal of nails and shingles from a roof. These need to be drawn out from the wood but shall never be cut. So any effect arising from a step used in the tool of Fieni has a completely different effect than a step according to the invention. The step according to Fieni is used to facilitate the drawing of nails and shingles out of the wood. More specifically, the step 136 of Fieni is configured such that the plane defined by the second section

138 is further from the workpiece during use in order to create a slot 132 to accommodate the body of the nail (as shown in Figure 7 of Fieni) in order to facilitate removal of the nail intact. If the step 136 was modified in a manner that would satisfy amended Claims 1 and 25 (i.e., such that the second section 138 is closer to the workpiece during use), shearing of the nail head off of the stub would be almost guaranteed, a result that is directly contrary to the main objective of Fieni (the main object being not to shear off the nail heads, but to remove the nails intact). Applicant respectfully submits that this is a classic case where the prior art reference explicitly and repeatedly *teaches away from* the modifications necessary to arrive at the claimed invention.

On the other hand, the step according to the present invention is used to allow a better cutting operation, in particular directly along a plane surface, and to allow cutting under geometrically very narrow conditions without interference by the fastener.

So, given this completely different purpose of the step, and the express teaching away from the claimed step in Fieni, Applicant respectfully submits that a person skilled in the art would never contemplate to include a step known from Fieni in the tool known from Fletcher et al. or Miller et al. in the precise manner claimed, absent using the present application as a roadmap.

For the foregoing reasons, Applicant respectfully submits that all pending claims, namely Claims 1-9, 13-17 and 25, are patentable over the references of record, and earnestly solicits allowance of the same.

Respectfully submitted,

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